Remarks

Claims 35-55 were pending before entry of the present amendment and claims 41-46 are withdrawn from consideration. Claims 35, 36, 37, and 47 have been amended to correct a grammatical error. In particular "a" has been corrected to "an" because the following noun begins with a vowel sound. Claims 47, 48, and 50 have been amended to more particularly point out and distinctly claim that which the Applicants regard as the invention. Support for the amendment to claims 47, 48, 50, and for new claim 56, can be found at page 29, line 10 to page 30, line 24, of the substitute specification filed on April 6, 2005. No new matter has been introduced. Claims 35-56 will be pending upon entry of the present amendment.

Priority

The specification of the instant application has been objected to because the first sentence of the specification does not accurately set forth the claim for priority. Applicants have amended the specification by replacing the first sentence with the sentence kindly provided by the Examiner. In view of the present amendment, Applicants respectfully request that the objection to the specification be withdrawn.

Oath/Declaration

The examiner has requested that the Applicants submit a new oath/declaration because the oath/declaration has not been signed and because the filing date for 07/440,053 is incorrectly indicated. Applicants respectfully point out that in a response to the Notice to File Missing Parts of Application under 37 C.F.R § 1.53 dated February 12, 2001 in connection with the above identified application, Applicants submitted a copy of the Declaration and Power of Attorney executed by the inventors and filed in the parent application, Serial No.

08/252,508, now U.S. Patent No. 5,854,037. However, a courtesy copy of the executed Declaration is submitted herewith.

With regard to the filing date of the 07/440,053 application, Applicants direct the Examiner's attention to the Amendments to the Specification, on page 3 of the present Amendment, where Applicants correctly indicate the filing date for parent Application 07/440,053 as November 21, 1989.

The Objections to Claims 35-40, 47, and 51-55 Should be Withdrawn

Claims 35-40, 47, and 51-55 have been objected to for failing to use the correct indefinite article, "an" instead of "a," preceding the term "mRNA." Independent claims 35-37, and 47 have been amended to recite "an mRNA." It follows that dependent claims 38-40 and 51-55 now also recite the term "an mRNA" in their reference to claims 35-37, and 46. Therefore, the objections to claims 35-40, 47, and 51-55 should be withdrawn.

The Rejections of Claims 47-52 under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

Claims 47-52 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner contends that the claims are all drawn to a method of constructing a DNA molecule but that the claims fail to describe the actual methods.

According to the applicable case law, 35 U.S.C. § 112, second paragraph, requires that the claims must have a clear and definite meaning when construed in the light of the complete patent document. Standard Oil Co. v. American Cyanamide Co., 774 F.2d 448, 227 U.S.P.Q. 293 (C.A.F.C. 1985). The test of definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. Orthokinetic Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 U.S.P.Q.2d 1081 (C.A.F.C. 1986).

Without making any admission to the merits of the Examiner's rejection, Applicants have amended claims 47, 48, and 50. Support for the claimed methods of constructing the DNA molecules can be found at page 29, line 10 to page 30, line 24, of the substitute specification filed on April 6, 2005. The amended claims recite a method step in addition to the preamble. Thus, the present amendment renders the rejection of claims 47-52 under 35 U.S.C. § 112, second paragraph, moot.

The Rejections of Claims 47-52 under 35 U.S.C. § 101 Should Be Withdrawn

Claims 47-52 were rejected under 35 U.S.C. § 101 as being non-statutory subject matter. The Examiner contends that the claims are all drawn to a method of constructing a DNA molecule but that the claims fail to disclose the actual methods. Without making any admission to the merits of the Examiner's rejection, Applicants have amended claims 47, 48, and 50. Support for the claimed methods can be found at page 29, line 10 to page 30, line 24, of the substitute specification filed on April 6, 2005. In view of the present amendment, Applicants respectfully request that the rejection of claims 47-52 under 35 U.S.C. § 101 be withdrawn.

The Statutory Type Double Patenting Rejection of Claim 35 Should be Withdrawn

Claim 35 was rejected under the judicially created doctrine of statutory type double patenting. The Examiner contends that claim 35 is identical in scope to claim 27 of U.S. Patent No. 5,166,057 unless the RNA sequence of claim 35 of the present invention does not by definition have to be heterologous. There is nothing in the language of the claim or in the specification that directly states or suggests that the RNA sequence must be heterologous. Because the RNA sequence does not by definition have to be heterologous, the statutory type double patenting rejection of claim 35 should be withdrawn.

The Double Patenting Rejection of Claims 35-40 and 53-55

Claims 35-40 and 53-55 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 8, and 27-20 of U.S. Patent No. 5,166,057 (the "057 patent"). Without acquiescing to the Examiner's rejection, Applicants will submit a Terminal Disclaimer under 37 C.F.R. § 1.321(b), (1) disclaiming any part of any patent granted on this application which could extend beyond the expiration date of the '057 patent; and (2) ensuring that any such patent granted on the application shall be enforceable only for and during such period that such patent is commonly owned with the '057 patent.

Applicant submits that the submission of the Terminal Disclaimer will obviate the rejection based on obviousness-type double patenting.

Conclusion

Applicant respectfully requests that the above amendments be entered and made of record in the present application file.

Respectfully submitted, by Jacqueline Bevan
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Date: December 22, 2005

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